

REMARKS

Claim Rejections

Claims 7-12 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 2-4 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s)mentioned in the description: The only sticker shown is 90 in FIG. 5 and FIG. 6-9 do not show that these showings are actual stickers if that is the intent. Claims 1, 2, 4, 7-14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamanini (5,295,695) in view of Yamagata (4,084,680) and further in view of Belokin et al. (5,458,231). Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tamanini in view of Yamagata and further in view of Belokin et al. and further in view of Tayebi (5,989,667). Claims 1, 2, and 4-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamanini in view of Yamagata and further in view of Lisenbigler (4,968,540). Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tamanini in view of Yamagata and further in view of Lisenbigler and further in view of Tayebi

Drawings

The Examiner has objected to the drawings under 37 C.F.R. § 1.83(a) insofar as the embodiments shown in Figures 6-9 are not labeled as stickers. However, Applicant directs the Examiner's attention to the Specification, p. 6, line 27 (a "3D decorative sticker 97" shown in Fig. 7), p. 6, line 22 (a "3D decorative sticker 96" shown in Figure 6), and p. 7, line 3 ("3D decorative stickers showing doll costume 903..."). In addition, as noted above, the specification has been amended to clarify that the boots 901 and handbag 902 are stickers ("a variety of stickers are shaped as woman's personal items, including high-heeled top boots 901, handbag 902..."). It is believed the foregoing obviate the outstanding objections.

Amendments to Specification

Applicant has amended the Specification as noted above to clarify that the items shown in Fig. 6-9 are stickers. It is believed that the foregoing amendments to the Specification overcome the outstanding objections thereto. No "new matter" has been added to the original disclosure by the foregoing amendments to the Specification.

New and Amended Claims

By this Amendment, Applicant has amended claims 1, 5, 12, and 15 and has added new claim 18 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

Claims 1 and 12 are directed towards a sticker set including a packing bag having a ***sealed upper edge*** and an open lower edge with an adhesive-applied flap downwardly extending, the ***open lower edge being prefolded*** to be folded upward to close the opening at said open lower edge and a ***hanging hole located between the upper edge and the substrate***. Claims 1 and 12 are further directed towards a set of individual 3D decorative stickers ***together creating a specific view***, the 3D decorative stickers being configured to ***display a 3D effect when in said packing bag***. Claim 12 is further directed towards a set of individual 3D decorative stickers showing costumes and animals ***being arranged on said substrate to create a specific fairy-tale view***. In addition, dependent claims are further directed towards a set of 3D decorative stickers formed by overlapping different constituent parts.

New claim 18 is directed towards a set of 3D decorative stickers having ***stacked and overlapped different planar parts to together form a scene with visual depth***.

Tamanini teaches a method of labeling gifts using adhesive backed gift labels in the form of stickers 26 on a release sheet 22. As admitted by the Examiner on page 4 of the most recent Office Action, the flap of the package 20 does not include a self-adhesive strip for closing an opening of the package 20. In addition, as

admitted by the Examiner on page 5 of the most recent Office Action, Tamanini does not teach 3D stickers.

Tamanini does not teach: a sticker set including a packing bag having a sealed upper edge and an open lower edge with an adhesive-applied flap downwardly extending, the open lower edge being prefolded to be folded upward to close the opening at said open lower edge and a hanging hole located between the upper edge and the substrate; a set of individual 3D decorative stickers together creating a specific view, the 3D decorative stickers being configured to display a 3D effect when in said packing bag; a set of individual 3D decorative stickers showing costumes and animals being arranged on said substrate to create a specific fairy-tale view; a set of 3D decorative stickers are formed by overlapping different constituent parts; or a set of 3D decorative stickers having stacked and overlapped different planar parts to together form a scene with visual depth.

Yamagata teaches a packaging article 1 having a flap 6 with adhesive tape. The flap has a folding line cut in the body 7 which must be folded after articles are placed in the package (Col. 2, ll. 46-50). A hole 14 is located in the center of the folding line 13. It is important to note that the flap is not prefolded, but is rather folded along the cut line after the package is filled. Applicant's also note that the location of the hole is a weak point in the package and, as compared with Applicant's invention, will more likely cause the package to burst result in the hangering ripping out and the package dropping from the display case.

Yamagata does not teach: a sticker set including a packing bag having a sealed upper edge and an open lower edge with an adhesive-applied flap downwardly extending, the open lower edge being prefolded to be folded upward to close the opening at said open lower edge and a hanging hole located between the upper edge and the substrate; a set of individual 3D decorative stickers together creating a specific view, the 3D decorative stickers being configured to display a 3D effect when in said packing bag; a set of individual 3D decorative stickers showing costumes and animals being arranged on said substrate to create a specific fairy-tale view; a set of 3D decorative stickers are formed by overlapping different constituent parts; or a set of 3D decorative stickers having stacked and overlapped different, planar parts to together form a scene with visual depth.

Belokin is cited as teaching 3D stickers. However, it is important to note that Belokin fails to teach a set of 3D decorative stickers are formed by overlapping different constituent parts; a set of 3D decorative stickers having stacked and overlapped different planar parts to together form a scene with visual depth; a set of stickers together arranged in the display package to form a specific view (fairy-tale, or otherwise); or that the stickers together display a 3D effect in the packing bag.

In addition, Belokin fails to teach: a sticker set including a packing bag having a sealed upper edge and an open lower edge with an adhesive-applied flap downwardly extending, the open lower edge being prefolded to be folded upward to close the opening at said open lower edge and a hanging hole located between the upper edge and the substrate; a set of individual 3D decorative stickers together creating a specific view, the 3D decorative stickers being configured to display a 3D effect when in said packing bag; a set of individual 3D decorative stickers showing costumes and animals being arranged on said substrate to create a specific fairy-tale view; a set of 3D decorative stickers are formed by overlapping different constituent parts; or a set of 3D decorative stickers having stacked and overlapped different, planar parts to together form a scene with visual depth.

Lisenbigler is cited as teaching as teaching a 3D sticker with curled paper of predetermined widths and overlapping fashion in the form of a bow. It is important to note that the bow itself is not a 3D sticker, but rather is a gift bow riveted to a sticker with a removable, peel-off sheet 24 . In addition, the curved ribbons are not planar, nor they disclose that they together form a 3D scene (fairytale or otherwise).

In addition, Lisenbigler fails to teach: a sticker set including a packing bag having a sealed upper edge and an open lower edge with an adhesive-applied flap downwardly extending, the open lower edge being prefolded to be folded upward to close the opening at said open lower edge and a hanging hole located between the upper edge and the substrate; a set of individual 3D decorative stickers together creating a specific view, the 3D decorative stickers being configured to display a 3D effect when in said packing bag; a set of individual 3D decorative stickers showing costumes and animals being arranged on said substrate to create a specific fairy-tale view; a set of 3D decorative stickers are formed by overlapping different

constituent parts; or a set of 3D decorative stickers having stacked and overlapped different, planar parts to together form a scene with visual depth.

Tayebi is cited as teaching a transparent substrate.

Tayebi fails to teach: a sticker set including a packing bag having a sealed upper edge and an open lower edge with an adhesive-applied flap downwardly extending, the open lower edge being prefolded to be folded upward to close the opening at said open lower edge and a hanging hole located between the upper edge and the substrate; a set of individual 3D decorative stickers together creating a specific view, the 3D decorative stickers being configured to display a 3D effect when in said packing bag; a set of individual 3D decorative stickers showing costumes and animals being arranged on said substrate to create a specific fairy-tale view; a set of 3D decorative stickers are formed by overlapping different constituent parts; or a set of 3D decorative stickers having stacked and overlapped different, planar parts to together form a scene with visual depth.

Even if the teachings of Tamanini, Yamagata, Belokin et al., Linsenbigler and Tayebi were combined, as suggested by the Examiner, the resultant combination does not suggest: a sticker set including a packing bag having a sealed upper edge and an open lower edge with an adhesive-applied flap downwardly extending, the open lower edge being prefolded to be folded upward to close the opening at said open lower edge and a hanging hole located between the upper edge and the substrate; or a set of individual 3D decorative stickers together creating a specific view, the 3D decorative stickers being configured to display a 3D effect when in said packing bag; a set of individual 3D decorative stickers showing costumes and animals being arranged on said substrate to create a specific fairy-tale view.

Nor does the combination suggest: a set of 3D decorative stickers are formed by overlapping different constituent parts; or a set of 3D decorative stickers having stacked and overlapped different, planar parts to together form a scene with visual depth.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected

prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Tamanini, Yamagata, Belokin et al., Linsenbigler or Tayebi that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Tamanini, Yamagata, Belokin et al., Linsenbigler nor Tayebi disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new and amended claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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By:



Bruce H. Troxell
Reg. No. 26,592

TROXELL LAW OFFICE PLLC
5205 Leesburg Pike, Suite 1404
Falls Church, Virginia 22041
Telephone: 703 575-2711
Telefax: 703 575-2707

CUSTOMER NUMBER: 40144